

REMARKS

By this Amendment, claim 18 is amended, and claims 61 and 63-72 are canceled. No new matter is added.

Allowable Subject Matter

Applicant acknowledges with thanks the Examiner's indication that claims 23, 52, and 59 recite allowable subject matter.

Claim Rejections: 35 U.S.C. § 103(a)

Claims 3, 18, 20-22, 24, 36-40, 43-45, 47-51, 54-58, 60, and 62 were rejected under 35 U.S.C. § 103(a) as reciting subject matter unpatentable over the Siccaprotect trade materials in view of WO 98/32421.

Applicant asks the Examiner to reconsider and withdraw this rejection because all pending claims call for the use of soft/day contact lenses, which are contraindicated for use with Siccaprotect.

The Examiner stated at the bottom of page 2 of the office action (continuing to p. 3) that the Siccaprotect "[t]radename information does not address the issue of the kind of contact lens to be disinfected." But the Examiner is mistaken. Heading 5 in document D1, "Contraindications" states "Siccaprotect® is not to be used when wearing soft contact lenses." Similarly, the last sentence in the "Contraindications" section of document D3 states "Soft (hydrophilic) contact lenses should not be worn while Siccaprotect® is being used."

Thus, the Siccaprotect documents make quite clear that Siccaprotect must not be used with soft contact lenses. Yet the present claims specifically require use of soft lenses. The Examiner cannot ignore the soft-lens contraindication in Siccaprotect; it is a clear and unresolvable difference between the cited art and the claimed subject matter. Because "[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention" (M.P.E.P. § 2141.03(VI), emphasis in original), and because the Siccaprotect materials permit

Ser. No. 10/615,592
Amendment G

absolutely no use with soft lenses, the Examiner cannot base an obviousness rejection of the pending claims on the Siccaprotect materials.

Respectfully submitted,
FOLEY HOAG LLP

Date: February 2, 2009
Customer No: 25181
Patent Group
Foley Hoag LLP
155 Seaport Boulevard
Boston, MA 02210-2600

/SCOTT E. KAMHOLZ/

Scott E. Kamholz
Reg. No. 48,543
Attorney for Applicants